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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,529	12/13/2000	Gerald W. Mills	723.040US1	8869

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EXAMINER
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TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/736,529

Applicant(s)

MILLS, GERALD W.

Examiner

A. Dexter Tugbang

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 9, 10 and 34-38.  
Claim(s) withdrawn from consideration: 1-8 and 11-33.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

A. Dexter Tugbang  
Primary Examiner  
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Attachment to Advisory Action

In the After Final response filed on April 5, 2006, the applicant(s) again assert that the prior art does not teach "...attaching a trace of conductive material ...a mandrel..." (lines 2-4 of Claim 9). The examiner again most respectfully disagrees.

The reference to Lawrence was relied upon to teach these features where the "trace of conductive material", "flexible insulating material", and "mandrel" were read as wire 22, insulative sheet 24, and tube 20, respectively. What do the applicant(s) mean when they say "attached"? Certainly Claim 9 does not recite how these elements are attached and the examiner maintains that they can be attached, not only because they are in direct contact with one another, but because the wire 22, sheet 24 and tube 20 are attached and *assembled together* as the final structure of a microcoil device (shown in Figs. 4 and 5). The whole intent of Lawrence is to produce the electromagnetic microcoil device such that it would electrically operate in an electromagnetic environment (col. 1, lines 2+). To say that these elements are not attached is simply not understood by the examiner, because that would mean that the structure (shown in Figs. 4 and 5) would fall apart and could not possibly operate in any electromagnetic environment, which goes completely against the very patent of Lawrence.

The applicant(s) further argue that Lawrence does not teach that the end of the insulative film 24 is pulled. The examiner again requests that applicant(s) look at Lawrence's Figure 3. To reiterate, sheet 24 has at least one end (located on the outer surface of the right vertical wall of tube 20). Clearly as the tube 20 and element 21 are rotated in the clockwise direction (annotated by the arrows in Fig. 3), the end of sheet 24 is pulled in order to wrap the sheet around the tube 20 and the wires 22. And again, the sheet 24 is attached to the tube 20 with the end of the sheet

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being pulled around the tube 20. If the applicant(s) do not believe that the sheet is attached to the tube and pulled, then how else would the sheet go form an initially flat surface, to the top horizontal surface of the tube 20, and then down and around to the right vertical surface of tube 20 when the tube is rotated clockwise?

So the examiner's position is that the conductive material 22 is attached to the sheet 24, sheet 24 is attached to the tube 20, and that the end of the sheet is pulled when rolled.

Regarding Claim 10, the applicant(s) assert that the secondary reference to Wohlhieter does not teach that the solderable attaching trace is electrically isolated from the trace of conducting material, and thus, would not be obvious to combine with Lawrence. The examiner presumes that this argument is supported by the applicant(s) specification where the conductive trace 45 is electrically isolated from a trace of conductive material 30 (lines 25-26, page 5). In reviewing the applicant(s) Figure 1, trace 45 is electrically isolated from trace 30 by a portion of insulating material 20 being in-between trace 45 and trace 30. The examiner's position is that Wohlhieter has this very same feature where the trace itself (e.g. 14) is electrically isolated from the trace of conductive material (e.g. winding 12) because a portion of insulating material (e.g. 21) is in-between trace 14 and trace 12. Therefore, the examiner maintains that the teachings of Wohlhieter would be obvious in view of Lawrence.